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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/617,689

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Hiromichi Ito

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EXAMINER

ISMAIL, SHAWKI SAIIF

ART UNIT

PAPER NUMBER

2155

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DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/617,689	Applicant(s) ITO, HIROMICHI	
	Examiner SHAWKI S. ISMAIL	Art Unit 2155	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 May 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) 1 and 7 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1/18/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMEDMENT

1. This communication is responsive to the Request for Continued Examination (RCE) amendments and remarks received on January 18, 2008 and more specifically to the restriction election received on April 4, 2008.

Claims 1-7 have been amended and are pending.

Claims 2-6 have been elected with traverse in the April 4, 2008 response and are hereby presented for further examination.

Claims 1 and 7 are hereby withdrawn from further consideration because they are non-elected claims.

References in applicant's IDS form 1449 received on January 8, 2008 have been considered.

The New Grounds of Rejection

2. Applicant's amendment and arguments received on October 18, 2008 have been fully considered, however they are deemed to be moot in view of the new grounds of rejection.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

4. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The claims recite "inherent global address" however the specification fails to provide proper antecedent basis for the claimed subject matter. Since support for this language is provided in the originally filed claims a new matter rejection is not required.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 2-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The claims recite “inherent global address” however the specification fails to define what inherent entails and as such renders the claim indefinite. Since the claims are directed toward allocating a temporary or rented address to a device the examiner will interpret the claimed “inherent global address” to be the permanent or real address of the device.

Claim Rejections - 35 USC §102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

7. Claims 2-3, are rejected under 35 U.S.C. 102(e) as being anticipated by **Levosky** U.S. Patent No. **7,054,906**.

Levosky teaches a system that allows an email sender to send emails without revealing the email sender's true Email address, but by instead utilizing an alias address allocated by an alias server that allows the sender to communicate anonymously without worrying about his/her true email address from being discovered and used for sending spam or unsolicited communications.

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8. As to claim 1, Levosky teaches a third information processing apparatus comprising:
a global address pool including rent-out global addresses (alias ;
correspondence information having a correspondence relationship between an inherent
global address and a rent-out global address,
wherein said inherent global address is allocated to a first information processing
apparatus, and
wherein said rent-out global address is set to said first information processing apparatus
by said third information processing apparatus.

3. (currently amended): A third information processing apparatus provided on a network
and performing rent-out of an address, said third information processing apparatus comprising:
a .global address pool including rent-out .global addresses;
correspondence information having a correspondence relationship among an inherent
global address, rent-out global address, and a. global address of a second information processing
apparatus,
wherein said inherent global address is allocated to a first information processing
apparatus,
wherein said rent-out global address is set to said first information processing apparatus
by said third information processing apparatus, and
wherein said second information processing apparatus is a partner information processing
apparatus with which said first information processing apparatus performs communication Using
said rent-out global address.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Levosky** U.S. Patent No. **7,054,906** in view of **Saito** U.S. Patent No. **7,317,798**.

As to claim 4, Levosky teaches the claimed invention as described above, Levosky does not explicitly teach wherein, in response to an inquiry from said second information processing apparatus, said third information processing apparatus notifies said second information processing apparatus, with encrypted communication, of said inherent global address allocated to said first information processing apparatus

Saito teaches a communication processing system, a communication processing method, a server, and a computer program, which allow a secure communication between communication terminals. Saito teaches the aforementioned secure communication between a calling party and a server when a calling party wishes to identify a called party's address and location data to place a call to the called party. The server generates address data of the called party, encrypts the address data using a private key established previously and transmits the encrypted address data to the calling terminal (col. 6, lines 29-44 and col. 14, lines 37-48).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the teaching of Saito into the invention of Levosky in order to enable a recipient of an email which was sent utilizing the alias email address to find out the true email address of the sender in a secure manner. The server would disclose the true email of the sender

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to trustworthy recipients to enable them to communicate with the sender directly, This type of secure communication would safeguard the sender from having to disclose his/her email address in an email in plaintext and have it become susceptible to interception from would be spammers (refer to Saito, col. 4, lines 42-54).

11. As to claim 5, Levosky teaches the claimed invention as described above, Levosky does not explicitly teach wherein permission to issue said notification is given only in a case of a combination of said global address of said second information processing apparatus and said inherent global address allocated to said first information processing apparatus, said global address of said second information processing apparatus and said inherent global address having a correspondence relationship in said correspondence information, and no permission is given to said notification in a case of a combination that does not exist in said correspondence information (refer to Saito col. 6, lines 29-44 and col. 14, lines 37-48, the encrypted address data of the called party is made available to the calling party only when the calling party contains the correct public/private key combination issued to both the called and calling party by the server.)

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to incorporate the teaching of Saito into the invention of Levosky in order to enable a recipient of an email which was sent utilizing the alias email address to find out the true email address of the sender in a secure manner. The server would disclose the true email of the sender to trustworthy recipients who contains the correct public/private key combination to enable them to communicate with the sender directly, This type of secure communication would safeguard the sender from having to disclose his/her email address in an email in plaintext and have it become susceptible to interception from would be spammers (refer to Saito, col. 4, lines 42-54).

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12. With regards to claim 6, it essentially contains similar limitations as that addressed in claim 3 and 4 above, therefore it rejected for similar reasons.

13. Examiner has cited particular columns and line numbers in the references as applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in its entirety as potentially teaching of all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

Prior Art of Record

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Please refer to form PTO-892 (Notice of Reference Cited) for a list of relevant prior art.

Response to Arguments

Applicant's arguments have been fully considered, however they are deemed moot in new of the new ground(s) of rejection.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shawki S Ismail whose telephone number is 571-272-3985. The examiner can normally be reached on M-F 8:30 - 5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar can be reached at 571-272-4006. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Shawki S Ismail/
Examiner, Art Unit 2155
August 16, 2008